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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91250143
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

THERAGUN, LLC, Opposer, v. THERAGEN, INC., Applicant.	Opposition No. 91250143 Serial Nos. 88/369,252; 88/369,266 Marks: THERAGEN and 

APPLICANT THERAGEN, LLC'S TRIAL BRIEF

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I. INTRODUCTION

"The party opposing registration bears the burden of proof, and if that burden cannot be met, the opposed mark must be registered." *B&B Hardware, Inc. v. Hargis Indus.*, 135 S. Ct. 1293, 1300 (2015). Opposer has failed to establish that the relevant consumers are likely to be confused between Applicant's THERAGEN™ prescription-only, electrostimulatory medical devices, which are only sold directly to licensed medical professionals, and Opposer's direct-to-consumer personal massage "guns" provided under the dissimilar mark THERAGUN—which clearly connotes the "gun" feature of the mark. The marks, the products, and the channels of trade are all sufficiently different to avoid any reasonable likelihood of confusion. Specifically:

The THERAGEN mark

- will be used for a regulated electrostimulatory device;
- the medical device is made available to patients solely by prescription from a licensed medical professional; and
- connotes a therapeutic device that is "next GENeration" and uses "GENerated" electrical stimulation.

The THERAGUN mark

- is used for a personal massager in the form of a gun;
- the massager is sold directly to end users via social media, online, and general retail;
- connotes a device that looks like a GUN.

These differences are dispositive on the issue of lack of any likely confusion. Further considering that the only shared component—THERA—is a weak term with respect to products with therapeutic qualities, the conclusion of no likely confusion is clear. Opposer's THERAGUN registrations coexist on the Register with nearly 70 other THERA- formative

marks. Twelve of those registered marks identify therapeutic devices, including goods identical to those covered by the asserted registration. They are:

- THERAVOLT for *electric percussion massagers*
- THERAVIBE for *electric, vibrating massagers*
- THERA-TREE for *therapeutic devices… used to provide physiological and metabolic benefit*
- THERATEMS for *massaging apparatus for personal use*
- THERA-STICK for *medical therapeutic apparatus for mobilizing tissue of the human body*
- THERAFLUX for *non-invasive electromagnetic neuromodulator devices*
- THERABUBBLE & Design for *physiotherapy apparatus*
- THERA GLIDE EST. 2014 for *medical devices, namely, a hand and foot medical device*
- THERA-TRAINER LYRA for *physical exercise apparatus for therapeutic use.*

Based on these facts, Opposer has failed to meet its burden in this Opposition.[1]

Accordingly, the Opposition should be dismissed and Applicant's marks allowed to register.

II. DESCRIPTION OF THE RECORD

The evidentiary record consists of:

1. Applicant's Application Serial Nos. 88/369,252 and 88/369,266 (made of record as subject of proceeding)
2. Opposer's Notice of Reliance filed on July 20, 2020 ("Opposer's NOR") (7 TTABVUE)

[1] As set forth herein and established in the concurrently filed Motion to Strike, Opposer cannot meet its burden in this proceeding because its two proffered testimony Declarations should be stricken. The witnesses were never disclosed and the proffered testimony is improper rebuttal.

3. Applicant's Notice of Reliance filed on September 16, 2020 ("Applicant's NOR") (11 TTABVUE)

4. Declaration of J. Chris McAuliffe filed on September 16, 2020 ("McAuliffe Decl.") (12 TTABVUE)

5. [Redacted] Confidential Trial Brief of Opposer Theragun, Inc. ("Opposer's Brief") (17 TTABVUE)

III. OBJECTIONS TO OPPOSER'S EVIDENCE

Applicant objects to, and has moved to strike, Opposer's Confidential Rebuttal Declaration of Kevin Tsao and Rebuttal Declaration of Dr. Jason Wersland. As established in Applicant's Motion to Strike, all of the proffered testimony is improper on rebuttal, because neither witness was disclosed by Opposer. Moreover, both Declarations contain nothing but evidence that should have been provided with Opposer's case-in-chief. The Board should strike both Declarations and decline to consider them in this matter.

IV. STATEMENT OF THE ISSUE

Are consumers likely to confuse the source of Applicant's FDA-regulated, prescription-only, electrostimulatory medical devices provided under the mark THERAGEN™ with the over-the-counter, percussive massage "guns" provided by Theragun under its mark THERAGUN, pursuant to the factors set forth in *In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973)?

V. BACKGROUND FACTS

A. Applicant and Its THERAGEN Marks and Products

Applicant is a medical device company. It creates medical-grade, non-invasive technologies utilized by medical professional on patients on a prescription-only basis.[2] Applicant began using its THERAGEN™ mark as a trade name in 2014 when Applicant began developing medical devices.[3] On April 3, 2019, Applicant applied to register Applicant's Marks for its products.[4] The USPTO did not cite any 2(d) conflicts and approved the applications for publication.

Applicant intends to use the marks THERAGEN™ and Theragen™ ("Applicant's Marks") on and in association with its prescription-only electrostimulatory devices.[5] Unlike Opposer's products, the THERAGEN products do not use any percussive or mechanical energy to deliver therapy.[6] Instead, Applicant's products will provide electrical stimulation only on a specific, isolated section of the body when in use, and cannot be freely moved about the body.[7]

Applicant's target customer are medical professionals, as Applicant's products will be available for use by prescription only.[8] Due to the need for a prescription, Applicant's products will not be sold online—either by Applicant itself or by third-party retailers.[9] Applicant also does not intend to sell its products "over-the-counter", nor is it allowed to do so per its representations to the FDA.[10]

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[2] McAuliffe Decl., ¶¶ 6, 16 (12 TTABVUE 3-4).
[3] *Id.*, ¶¶ 6-7 (12 TTABVUE 2).
[4] Applicant's NOR, Exhs. 77-78 (11 TTABVUE 371-375)
[5] McAuliffe Decl., ¶¶ 9-10 (12 TTABVUE 3).
[6] *Id.*, ¶¶ 8-9.
[7] *Id.*, ¶¶ 9-10.
[8] *Id.*, ¶¶ 16-17 (12 TTABVUE 4-5).
[9] *Id.*, ¶ 15 (12 TTABVUE 4).
[10] *Id.*, ¶¶ 11, 16. (12 TTABVUE 3, 4).

B. Opposer and Its THERAGUN Mark and Products

Opposer is the owner of U.S. Reg. No. 5,213,141 (THERAGUN) for "*massage apparatus; massage apparatus for massaging injured muscles; vibrating apparatus used to stimulate muscles and increase strength and physical performance for health and medical purposes; electric massage appliances, namely, electric vibrating massager; electric massage appliances, namely, electric vibrating massager,*" and for U.S. Reg. No. U.S. Reg. No. 4,760,327 (THERAGUNZ) for "*Vibrating apparatus used to stimulate muscles and increase strength and physical performance for health and medical purposes.*" ("Opposer's Marks").[11] In practice, Opposer's THERAGUN products are personal electric massage devices having a form-factor similar to a handheld firearm (i.e., therapeutic "guns").[12] Instead of using electrical stimulation, Opposer's products use mechanical vibration as their treatment modality.[13] Purchasers of Opposer's products do not need a prescription to purchase Opposer's devices. Indeed, Opposer's devices can be purchased by anyone at any time, and are sold through a variety of online and retail outlets.[14]

VI. OPPOSER HAS NOT MET ITS BURDEN OF SHOWING ANY REASONABLE LIKELIHOOD OF CONFUSION

Likelihood of confusion is a fact-specific inquiry dependent on the facts presented in each case. *In re Shell Oil Co.*, 992 F.2d 1204, 1206, 26 U.S.P.Q.2D (BNA) 1687, 1688 (Fed. Cir. 1993). The inquiry is generally viewed within the context of thirteen factors set out in *In re E. I. Du Pont de Nemours & Co.*, (the "DuPont Factors"). 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). However, "[n]o mechanical rule determines likelihood of confusion," and only

[11] Opposer's Brief, p. 3 (17 TTABVUE 8).
[12] *Id.*
[13] *Id.*, p. 8 (17 TTABVUE 13).
[14] Opposer's NOR, Exh. 60, p. 3 (7 TTABVUE 186).

factors applicable to the mark at hand need be considered. *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94 U.S.P.Q.2D (BNA) 1257, 1258 (Fed. Cir. 2010). Furthermore, consumer confusion must be probable, not simply possible, in order for a likelihood of consumer confusion to be found. 4 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:3, at 23-52 (5th ed. 2019).

Here, the DuPont Factors most germane to Opposer's failure to prove likelihood of confusion are:

1. The lack of similarity of the marks as to appearance, sound, and meaning;
2. The lack of similarity of the goods in the registrations;
3. The lack of similarity of the trade channels;
4. The high number and nature of similar marks in use on similar goods;
5. The lack of fame of Opposer's Marks; and
6. The high level of sophistication of buyers to whom Applicant's sales are made.

Opposer fails to establish that the DuPont factors establishing reasonable likelihood of confusion. Accordingly, Opposer has not met its burden to establish a likelihood of confusion between THERAGUN and THERAGEN, and the Opposition should be dismissed.

A. Applicant's Marks Are Unique In Sight, Sound, And Commercial Impression From Opposer's Marks

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *Federated Foods, Inc. v. Fort Howard Paper Co.,* 544 F.2d 1098, 192 U.S.P.Q. 24 (C.C.P.A. 1976) ("The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks"). Here, the marks are not "identical or very or substantially similar," given their distinct appearance, sound, and commercial meaning.

First, THERAGEN is dissimilar both visually and phonetically from THERAGUN. While both marks contain the prefix "THERA", Applicant's Marks contain the suffix "GEN", which is pronounced "jen" and which is not a recognized word with any particular meaning apart from the connotation arising from the mark.[15] Opposer's Marks have an entirely different second syllable: "GUN" or "GUNZ"— with a hard "g".[16] The second and primary syllable in Opposer's marks is a clearly recognized word—GUN—with a clear and specific meaning in relation to the product, discussed below These differences are key because where, as here (see Section D, *supra*), the consuming public is exposed to numerous third party uses of similar marks for related goods and services, consumers will look to differences in the marks (as well as differences in the goods or services themselves) to distinguish their source and are not likely to be confusion. *See General Mills, Inc. v. Health Valley Foods*, 24 U.S.P.Q. 1270, 1278 (T.T.A.B. 1992). Even with the similar prefix, the marks' respective suffixes are sufficiently distinct as to nullify any likelihood of confusion based on differing appearance and pronunciation.

Moreover, "[e]ven where the marks at issue are identical, or nearly identical, the Board has found that differences in connotation can outweigh visual and phonetic similarity." *Coach Servs.*, 668 F.3d at 1368. As discussed above, the marks are not even "nearly identical," but in addition, the marks have distinct connotations. "GEN" does not have a formal definition, but is often used as the short form for the term "generation".[17] On the other hand, "GUN" is defined as "a portable firearm," which is incorporated into Opposer's Marks to allude to Opposer's products' resemblance to portable tools or guns.[18] In other words, the THERAGUN mark is

[15] Applicant's NOR, Exh. 73, p. 2 (11 TTABVUE 305).
[16] *Id.*, Exh. 74, p. 2 (11 TTABVUE 318).
[17] *Id.*, Exh. 73, p. 2 (11 TTABVUE 305).
[18] *Id.*. Exh. 74, p. 2 (11 TTABVUE 318).

designed to elicit an image of a therapeutic firearm, whereas THERAGEN elicits an association with electrical "generation," as its products are intended to supply.

These separate meanings and allusions of the respective marks results in distinct and unrelated connotation between the two, and, coupled with their distinct appearances and pronunciations, render confusion unlikely.

B. The Parties' Respective Goods are Distinct and Unrelated

To establish a likelihood of confusion, it is not enough that the marks be similar. It is also required that there be a relatedness of goods between the respective marks. *See, e.g., In re Steamboat Springs Chamber-Resort Ass'n, Inc.*, 10 TTABVUE 2-3 (T.T.A.B. March 31, 2012) (reversing Section 2(d) refusal to register the applied-for trademark, BIKE TOWN USA, despite the fact that the applied-for mark and the cited mark, BIKETOWN, were virtually identical, noting the fact that applicant's athletic competition services were not necessarily related to registrant's promotional contests even though some promotional contests are athletic competitions). There is no *per se* rule that certain goods or services are related - each case and the products and services involved must be considered on their own merits. *See* TMEP §1207.01(a)(iv).

Here, Applicant's goods are not "related" to Opposer's goods. While the respective goods may broadly pertain to goods used in the treatment or management of or therapy for muscle pain and injury, that alone is not sufficient to create a likelihood of confusion. The Board has consistently held that goods belonging in the same general category of products does not necessarily result in "relatedness".

For example, in *In re White Rock Distilleries Inc.*, an applicant sought to register the mark VOLTA for "energy vodka infused with caffeine" but was refused registration by the trademark Examining Attorney under Section 2(d) of the Trademark Act due to a prior

registration for TERZA VOLTA & Design for "sparkling fruit wine; sparkling grape wine; sparkling wine; wines." 92 U.S.P.Q.2D (BNA) 1282 (T.T.A.B. October 5, 2009). However, the Board found that the parties' respective goods were unrelated, noting, "[a]lthough vodka and wine may both be described generally as 'alcoholic beverages,' this is insufficient to establish that applicant's and registrant's goods are related." *Id.*, at 1285.

Similarly, in *In re British Bulldog, Ltd.*, an applicant sought to register the mark PLAYERS in stylized font for men's underwear. The applicant's registration was refused under Section 2(d) of the Trademark Act due to a prior registration of an identical mark for men's shoes. This Board concluded that men's underwear is unrelated to men's shoes, despite the fact that both are items of clothing sold in some of the same department stores to some of the same consumers, because they are distinctly different products that would ordinarily be displayed in distinctly different sections of the store, and are not complementary items. 224 U.S.P.Q. (BNA) 854, 855-856 (T.T.A.B. November 1, 1984).

A final noteworthy example is this Board's holding in *Interstate Brands Corp. v. Celestial Seasonings, Inc.* There, this Board held that a mark for THE RED ZINGER for tea was not confusingly similar to ZINGERS for cakes, despite the fact that both goods fell under the broad umbrella term of consumables and were sold in grocery stores. 576 F.2d 926, 927-28, 198 U.S.P.Q. 151 (C.C.P.A. 1978) (approving *Interstate Brands Corp. v. Celestial Seasonings, Inc.,* 196 U.S.P.Q. 321 (T.T.A.B. June 30, 1997)).

Much like the cases cited above, both Opposer's and Applicant's products provide therapy, but that is where any similarity between the respective goods ends. Opposer's goods are household personal percussive massagers used by athletes and average citizens alike.[19]

[19] Opposer's NOR, Exh. 64, p. 1 (7 TTABVUE 217).

Opposer's goods solely use percussion to provide therapy, and do not use electrical stimulation.[20] In contrast, Applicant's products are meant for patients of licensed medical professionals who receive a prescription for a specific electrostimulatory therapy.[21] Applicant's products do not use percussion or mechanical energy as the therapeutic mechanism, only electricity.[22] Further, unlike Opposer's goods, which are not attached to the body by any means other than the user's hand, Applicant's goods are stationary and cannot be easily moved between body locations.[23] Likewise, because of the nature of the electrical stimulation component, Applicant's intended products will be visually distinct from Opposer's products and do not resemble guns. Thus, while both provide therapy, the parties' products do so in entirely separate and different ways, and through wholly unrelated mechanisms, and therefore cannot be considered "related" for the purposes of analyzing likelihood of confusion.

Opposer's own argument supports the lack of relatedness. Opposer solely asserts (based on evidence from an inadmissible declaration) that the parties' goods are "complementary" as "therapy" devices to be used "as part of [a] fitness, health, wellness, recovery, or therapy plan."[24] Yet Opposer cites to no legal authority establishing how the goods being generally "complementary" somehow equates to related goods for the purposes of assessing likelihood of confusion. In fact, such a suggestion is antithetical to the T.T.A.B. decisions discussed *infra*. Even assuming, *arguendo*, the parties' goods may both be described generally as "therapy devices" as Opposer implies, this is insufficient to establish that the goods are related, as this Board has recognized that it is not enough to find one term that may generically describe the

[20] *Id.*, Exh. 63, p. 5 (7 TTABVUE 209); McAuliffe Decl., ¶¶ 8-9 (12 TTABVUE 3).
[21] McAuliffe Decl., ¶ 17 (12 TTABVUE 4-5).
[22] *Id.*, ¶¶ 8-9 (12 TTABVUE 3).
[23] *Id.*, ¶¶ 9-10 (12 TTABVUE 3).
[24] Opposer's Brief, p. 8 (17 TTABVUE 13).

goods to establish relatedness. See *General Electric Company v. Graham Magnetics Inc.*, 197 U.S.P.Q. (BNA) 690 (T.T.A.B. 1977).

Wine and vodka are both "alcoholic beverages," and at the same time are not related. Underwear and shoes are both "clothing," and yet are not related. So too are tea and cakes "consumables," but not related. As with these examples, the therapeutic guns offered under Opposer's Marks and the electrostimulatory devices offered under Applicant's Marks may both be generally considered "therapy products," but as with the previous examples, are not related.

Accordingly, this also establishes that there is no likelihood that Applicant's Marks will be confused with Opposer's Marks.

C. Applicant's and Opposer's Goods Will Travel Different Trade Channels

As is the present case, there can be no reasonable likelihood of confusion where the goods and services of the parties travel through different trade channels. *See Checkpoint Sys., Inc. v. Check Point Software Tech., Inc.*, 269 F.3d 270, 281, 60 U.S.P.Q.2d 1609, 1620 (3d. Cir. 2001); *see also In re Fesco, Inc.*, 219 U.S.P.Q. (BNA) 437 (T.T.A.B. 1983) (dissimilarities in trade channels prevented likelihood of confusion between FESCO for farm equipment distributorship services and FESCO for fertilizer, oil mills, crushed stone, clay, coal, concrete blocks, and foundry processing equipment); *Chase Brass and Copper Company, Inc.*, 199 U.S.P.Q. (BNA) 243 (T.T.A.B. 1978) (no likelihood of confusion between BLUE DOT for springs for use with engine distributors and BLUE DOT for brass rods used in auto manufacturing, because consumers of such products were unlikely to encounter both products in commerce).

Here, as in the cases cited above, there is virtually no opportunity for confusion because the respective goods will never appear in the same store or on the same websites. Opposer offers no substantive evidence establishing that the parties' trade channels (prescription-only provision

via medical professionals versus general online retail) are closely related or identical and ignores the evidence submitted by Applicant establishing quite the opposite. Applicant's goods will only be sold directly to licensed medical professional, and provided only to those professional's end-users once a prescription is obtained.[25] Thus, Applicant's products cannot be obtained by the average consumer without the assistance of a licensed medical professional, and because of this, Applicant's goods cannot be, and will not be, marketed or sold to the general public at everyday athletic stores or online, as evidenced by Applicant's submissions to the FDA regarding its products.[26]

Instead of the extremely restricted trade channels by which Applicant sells its products, Opposer's products, quite conversely, can be purchased by anyone at any time.[27] Opposer's products can be purchased through Opposer's own website or through third-party retailers without a prescription and without consulting a medical professional.[28]

As Applicant's goods will be sold in a different trade channel from Opposer's goods and, unlike Opposer's goods, will not be sold to the public in a general fashion, confusion is not likely.

D. Opposer's Marks and Applicant's Marks Coexist With a High Number of Other THERA-Formative Marks in Class 10

Even though Applicant's Marks share the same common prefix as Opposer's Marks, numerous other third-party THERA-formative marks coexist with the mark THERAGUN, including certain THERA-formative marks with nearly identical goods as Opposer. Evidence of

[25] McAuliffe Decl., ¶ 16 (12 TTABVUE 4).
[26] *Id.*, ¶¶ 15-16 (12 TTABVUE 4).
[27] *See* Opposer's NOR, Exh. 66, p. 4 (7 TTABVUE 232) ("Its [Theragun's] popularity has now permeated entertainment, with the company experiencing an influx of A-List celebrities purchasing the device like normal people (that is, directly from the site…)").
[28] *See*, *for example*, Opposer's NOR, Exh. 60, p. 3. (7 TTABVUE 186).

third-party use of similar marks for similar goods and services is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection, such that the public will look to other elements to distinguish the source of the goods and services. TMEP § 1207.01(d)(iii); *Palm Bay Imports, Inc. v. Vueve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1373, 73 U.S.P.Q.2d 1689, 1693 (Fed. Cir. 2005). Opposer ignores the fact that the coexistence of these other THERA-marks used for related goods indicates that confusion is unlikely.

Indeed, the greater the number of identical, or more or less similar, trademarks already in use, the less is the likelihood of confusion. *Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252, 259-60 (5th Cir.), *cert. denied*, 449 U.S. 899, 101 S. Ct. 268, 66 L. Ed. 2d 129, 208 U.S.P.Q. (BNA) 464 (1980), *quoting* Restatement of Torts § 729 comment g. In *Amstar Corp.*, Amstar Corporation, a sugar company, sought to enjoin Domino's Pizza, Inc. from using the mark DOMINO in connection with hot pizza sales and delivery services. *Id.*, at 254. As part of its defense, Domino's Pizza introduced into evidence approximately 72 third-party registrations of the mark "DOMINO" used for a variety of products, a number of which were food products. *Id.* at 259. The Fifth Circuit ruled in favor of Domino's Pizza, finding that the coexistence of numerous third-party party registrations for similar marks limited the protection to be accorded to Amstar Corporation's mark, and that Amstar Corporation's mark warranted protection only as it related to sugar products. *Id.*, at 260, 265.

Similar to *Amstar Corp.*, at present there are 65 coexisting federal registrations for THERA-formative marks in Class 10 for various medical and therapeutic devices and products.[29] Of these prior registrations, twelve specifically cover massage or therapy devices for the human body, namely:

[29] Applicant's NOR, Exhs. 1-51, 53- 66 (11 TTABVUE 20-167, 171-210).

- THERAVOLT for *electric massage appliances, namely, electric percussion massagers*;[30]

- THERAVIBE for *electric massage appliances, namely electric, vibrating massager*;[31]

- THERA-TREE for *therapeutic devices… used to provide physiological and metabolic benefit*;[32]

- THERATEMS for *massage sticks, massaging apparatus for personal use; massage apparatus*;[33]

- THERA-TRAINER LYRA for, among other goods, *physical exercise apparatus for therapeutic use*.[34]

- THERA-STICK for, among other goods, *medical therapeutic apparatus for mobilizing tissue of the human body to enhance fitness, sports performance, physical therapy, occupational therapy, activities of daily living, accelerating healing, and decreasing pain for medical purposes*;[35]

- THERA-ROLL for *medical therapeutic apparatus for mobilizing tissue of the human body to enhance fitness, sports performance, physical therapy, occupational therapy, activities of daily living, accelerating healing, and decreasing pain for medical purposes*;[36]

- THERAFLUX for *non-invasive electromagnetic neuromodulator devices for medical use by healthy and impaired persons to enhance health and wellness; THERA CANE for hand tool for massaging parts of a body*;[37]

- THERABUBBLE & Design for, among other goods, *physiotherapy apparatus*;[38]

- THERA-BAND FIRST STEP TO FOOT RELIEF for *a kit that includes a non-electric foot massage apparatus*;[39] and

- THERA GLIDE EST. 2014 & Design ("EST. 2014" disclaimed) for *medical devices, namely, a hand and foot medical device for increasing range of motion,*

[30] *Id*., Exh. 1 (11 TTABVUE 20-22).
[31] *Id*., Exh. 2 (11 TTABVUE 23-25).
[32] *Id*., Exh. 5 (11 TTABVUE 32-34).
[33] *Id*., Exh. 9 (11 TTABVUE 43-45).
[34] *Id*., Exh. 6 (11 TTABVUE 35-37).
[35] *Id*., Exh. 12 (11 TTABVUE 52-54).
[36] *Id*., Exh. 19 (11 TTABVUE 73-75).
[37] *Id*., Exh. 34 (11 TTABVUE 116-117).
[38] *Id*., Exh. 40 (11 TTABVUE 133-135).
[39] *Id*., Exh. 43 (11 TTABVUE 142-144).

for range of motion patients, athletes, senior citizens, person requiring increased range of motion.[40]

Given such an extensive list of coexisting similar marks on the register, Opposer's Marks, like *Amstar's* DOMINO, are only to be extended the protection it is "clearly entitled thereto." *Amstar Corp.*, 615 F.2d at 265. At best, Opposer has rights to potentially exclude others from using a mark *identical* to THERAGUN or THERAGUNZ for percussive massagers, but nothing more.

The evidence of coexisting marks used for highly similar goods to those of Opposer makes irrefutable the fact Opposer's Marks are entitled only to a narrow scope of protection. The co-existence of these third-party marks show that consumers are able to discern as to the source of goods between Opposer's Marks and the aforementioned marks based on the differences therein without difficulty, despite sharing a common prefix. There is therefore no reason these same consumers will not also be able to differentiate between Applicant's significantly different marks as used in the context of its very different goods, dispelling any probability of confusion. THERAGEN should also be allowed to be registered and share the space occupied by so many other THERA-formative marks in the general "therapy" field.

E. Opposer's Marks Are Not Famous

Opposer has not submitted sufficient evidence to establish that Opposer's Marks are famous for purposes of a likelihood of confusion analysis. The only admissible evidence cited by Opposer regarding the fame of THERAGUN are various write-ups and reviews.[41] At best, these records show only that Opposer has received some favorable press (unclear if paid or unsolicited) limited to the field of percussive hand-held personal massagers. For example, one cited review

[40] *Id.*, Exh. 59 (11 TTABVUE 188-190).
[41] Opposer's NOR, Exhs. 60-77 (7 TTABVUE 183-326).

refers to Opposer's THERAGUN product as "…a popular recovery gadget that looks like an electric drill. …It works like one, too."[42] A second reviewer identifies the product as a "gun" and writes that "[t]he Theragun looks more like a power tool."[43] Another write-up goes so far as to call Opposer's product "a mini-jackhammer" and that utilizing the product "feels like getting hundred-hand-slapped by a buff leprechaun."[44] The common theme in these third-party write-ups is that the THERAGUN mark might be associated with a hand-held massaging tool for muscles, nothing more. It does not establish that Opposer's Marks are famous.

Fame of an opposing mark, for purposes of a likelihood of confusion analysis, is "a matter of degree." *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 1367, 101 U.S.P.Q.2D (BNA) 1713, 1720 (Fed. Cir. 2012). Fame "varies along a spectrum from very strong to very weak." *Palm Bay Imports, Inc.*, 73 U.S.P.Q.2d at 1694. To establish strong fame, a party must put forth evidence such as "large market shares" or "large advertising expenditures in a product line." *Bose Corp. v. QSC Audio Prods.*, 293 F.3d 1367, 1375, 63 U.S.P.Q.2D (BNA) 1303, 1309 (Fed. Cir. 2002). Without such evidence, a mark's fame can only be considered weak. But other than the various press clippings discussed above, Opposer has not submitted any other admissible evidence of fame.[45] Therefore, Opposer's Mark cannot be considered famous (i.e., Opposer's Mark is "very weak").

Where a mark is weak, it is only entitled to a narrow scope of protection, and therefore minor differences with other marks will obviate any likelihood of confusion. *See e.g., In re Central Soya Co. Inc.*, 220 U.S.P.Q. (BNA) 914, 916 (T.T.A.B 1984) (stating weak designations

[42] Opposer's NOR, Exh. 61., p. 2 (7 TTABVUE 195).
[43] *Id.*, Exh. 65., p. 1 (7 TTABVUE 223).
[44] *Id.*, Exh. 64., pp. 2, 4 (7 TTABVUE 218, 220).
[45] Opposer's only other evidence beyond its press clippings comes from the Tsao Declaration, which Applicant has moved to strike.

are entitled to a narrow scope of protection than an entirely arbitrary or coined word); *King Candy Co. v. Eunice King's Kitchen*, 96 F.2d 1400, 1401, 182 U.S.P.Q. 108, 109-110 (C.C.P.A. 1974) (stating that where marks are weak, consumers easily distinguish between minor differences in the marks). Opposer's lack of fame, considered against the totality of the circumstances as to the significant differences between the respective marks discussed herein, further establishes that confusion between Opposer's Marks and Applicant's Marks is highly unlikely.

F. Applicant's Consumers are Highly Sophisticated

Applicant's target consumers are prescribing physicians.[46] The Board has on multiple occasions held that purchasers of medical devices, in particular doctors, are some of the most sophisticated purchasers. See *In re Wright Med. Tech., Inc.*, 1998 TTAB LEXIS 392, *11 (T.T.A.B. October 30, 1998)[47] ("The sophisticated buyers -- physicians and/or hospital purchasing agents -- would readily recognize the difference in the appearance of the marks if she or he is acquainted with one mark and subsequently sees the other."); *In re Inspired Techs., Inc.*, 12 TTABVUE 10 (T.T.A.B. January 19, 2011) ("It has long been recognized that purchasers of medical equipment, whether hospital personnel or physicians, are highly sophisticated and, as such, are more likely to distinguish between marks and goods than is the general consuming public.); s*ee also Pfizer Inc. v. Astra Pharmaceutical Products Inc.*, 858 F.Supp. 1305, 33 USPQ2d 1545, 1562 (S.D.N.Y. 1994) ("[t]he consumers here are doctors, as sophisticated a group as one could imagine").

This is particularly due to a physician's status as a prescriber for his or her patients. "While patients, as the ultimate consumers, would admittedly lack such specialized knowledge, it must be remembered that unlike the case with over-the-counter medications, it is the patient's

[46] McAuliffe Decl., ¶ 17 (12 TTABVUE 4-5).
[47] Decision attached as Exhibit A.

doctor or pharmacist which, in the case of prescription drugs, selects the medication and the patient, relying upon the expertise of the medical practitioner, simply has his or her prescription filled without the need for any deliberation." *SmithKline Beecham Pharms. Co. v. L. Molteni & C. dei F.lli Alitti S.p.A.*, 2000 TTAB LEXIS 626, *20 (T.T.A.B. September 18, 2000)[48] (confusion unlikely where "respective goods would be marketed primarily to careful and sophisticated medical professionals who plainly would not impulsively select and prescribe the products for their patients").

As discussed above, Applicant's target market for its THERAGEN products is the highly sophisticated medical professionals who will be prescribing the THERAGEN electrostimulatory therapy device to their patients. These sophisticated professionals will be more than able to discern between the two dissimilar marks, particularly in light of the very different nature of the respective goods and their disparate trade channels, making confusion extremely unlikely.

V. CONCLUSION

The parties' unrelated goods are offered under distinctive marks through separate trade channels. There exist nearly 70 other active THERA- registrations in the "therapy device" space, indicating consumers can distinguish between these registrations' respective sources. Opposer's Marks are only known for its particular product, and the consumers of Applicant's product are highly sophisticated and discerning. Considering all of the relevant factors, Opposer cannot meet its burden of establishing likely confusion. Applicant therefore respectfully requests that the Board dismiss this Opposition and allow Applicant's Application Serial Nos. 88/369,252 and 88/369,266 to pass to registration.

[48] Decision attached as Exhibit B.

Date: January 29, 2021

Respectfully submitted,

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CERTIFICATE OF SERVICE

I, Kristel Tupja, hereby certify that a true and correct copy of Applicant's Trial Brief was served on the Attorneys of Record for the Opposer by e-mail on the date below:

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/Kristel Tupja/
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Exhibit A

1998 TTAB LEXIS 392

Trademark Trial and Appeal Board

October 30, 1998, Decided

Serial No. 75/024,024

Reporter
1998 TTAB LEXIS 392 *

In re Wright Medical Technology, Inc.

Disposition: [*1]

Decision: The refusal to register is reversed.

Core Terms

registrant's, marks, Trademark, orthopedic, products, implants, hip, sophisticated, specialized, likelihood of confusion, appearance, marketing, comprise, overlap, surgeon, therapeutical, third-party, purchasing, channels, register

Counsel

Russell H. Walker of Walker McKenzie & Walker, P.C. for Applicant.

Tina L. Snapp, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Panel: Before Hohein, Chapman and Bucher, Administrative Trademark Judges.

Opinion By:

Bucher, David E.

Opinion

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Opinion by Bucher, Administrative Trademark Judge:

Applicant, Wright Medical Technology, Inc., has filed an application for registration of the mark "EXTEND" for "medical apparatus, namely, orthopedic hip implants." [1]

The Trademark Examining Attorney issued a final refusal to register based upon *Section 2(d)* of the Trademark Act, *15 U.S.C. § 1052(d)*, on the ground that applicant's proposed mark, "EXTEND," when used on orthopedic hip implants, so resembles the registered mark, "X-TEND" for "carpal tunnel supports, elbow supports, thumb/wrist supports, back braces, all for medical or therapeutic use," [2] as to be likely to **[*2]** cause confusion, or to cause mistake, or to deceive.

Applicant has appealed the final refusal to register. Briefs have been filed but applicant did not request an oral hearing. We reverse the refusal to register.

With respect to the refusal on the ground of likelihood of confusion, applicant asserts that the chances for confusion are remote because the respective goods are used in different medical specialties; that those who prescribe these goods are extremely sophisticated; and, that, in reality, the products are so very different that one can conclude there is no overlap in the channels of trade for these respective goods. Furthermore, applicant notes that the trademarks are different as to spelling and appearance.

The Trademark Examining Attorney contends that the goods of both parties are medical devices in the nature of orthopedic products. The Examining Attorney concedes that applicant's target audience may be narrower than that of registrant. However, according to the Examining Attorney, there is a strong presumption that applicant's goods will be marketed, for example, **[*3]** to purchasing agents in hospitals, as would registrant's goods. Such a medical professional might reasonably believe that a manufacturer offering a product like orthopedic hip implants might also sell back braces and external support devices for the extremities. Finally, the Trademark Examining Attorney points out that even sophisticated purchasers can be confused by identical or highly similar trademarks. Consequently, the Examining Attorney finds that hip implants are so closely related to back braces and external medical/therapeutical support devices that confusion as to the origin or affiliation of the respective goods is likely to occur.

In the course of rendering this decision, we have followed the guidance of *In re E.I. DuPont DeNemours & Co., 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973)*, which sets forth the factors which, if relevant, should be considered in determining likelihood of confusion. [3]

As has often been stated, **[*4]** it is well settled that goods need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed thereon, to the mistaken belief that they originate from or are in some way associated with the same producer. *See, e.g., Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 595-96 (TTAB 1978)* and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). Here, however, the precision medical apparatus manufactured and sold by applicant is a very specialized device. Orthopedic surgeons comprise applicant's target audience. Even if hospital purchasing agents and administrators are the professionals placing the order in a given medical facility, they would do so only as directed by the attending orthopedic implant surgeon.

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[1] Serial No. 75/024024, in International Class 10, filed November 17, 1995, based on an allegation of a *bona fide* intention to use the mark in commerce.

[2] Reg. No. 1,707,740, issued August 18, 1992; § 8 affidavit accepted & § 15 affidavit received.

[3] We have not considered the declaration of Mr. Thomas M. Patton, applicant's President and Chief Executive officer, filed with the reply brief, since the Patton declaration is untimely under Trademark Rule 2.142(d).

According to applicant, registrant designs, manufactures and markets medical and therapeutical devices. **[*5]** This type of product is prescribed by physicians, fitted by therapists specializing in rehabilitation, and should be available at retail to members of the general public (e.g., in one's local pharmacy). Registrant's listed items tend to be less expensive than applicant's goods, as manufactured they are fungible, they are intended for external support only, and according to applicant, would not be prescribed by an orthopedic surgeon. Conversely, applicant points out the obvious -- that physicians or therapists who specialize in occupational medicine and use registrant's therapeutic products would not be involved in the decisions surrounding hip replacement surgery. (Applicant's brief, pp. 3-4)

The record includes printouts of seven federal trademark registrations where goods resembling those of applicant and registrant are listed on the same certificate. These third-party registrations are submitted as evidence of the asserted relatedness of the respective parties' goods involved herein. While we have considered the evidence of these third-party registrations, its probative value is limited.

On the one hand, these registrations do show that seven entities have registered their **[*6]** marks for goods of the type recited by applicant and for goods listed by registrant. Registrations which individually cover a number of different items and which are based on use in commerce may have some probative value. Their value is the suggestion that the listed goods are of a type that may well emanate from a single source.

On the other hand, no third-party registration demonstrates that the marks shown therein are in commercial use. Federal trademark registrations do not prove that members of the relevant public are familiar with the marks.

Furthermore, third-party registrations that issued under *Section 44(e)* of the Act, *15 U.S.C. § 1126(e)*, without any use in commerce basis, have almost no persuasive value. In the instant case, three of the seven third-party registrations made of record by the Trademark Examining Attorney issued under the provisions of *Section 44(e)* of the Act, based only upon ownership of a foreign registration. Such registrations have very little, if any, persuasive value on the point for which they were offered. *In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993)*, and cases cited therein.

The **[*7]** Trademark Examining Attorney is correct that both parties' products are medical devices in the field of orthopedics. Otherwise, applicant's goods are significantly different from registrant's goods. They are quite different in the manner in which they function and the ways in which they are intended to be utilized.

That both parties are marketing orthopedic devices does not mandate a finding that the products are related or that confusion is likely. After all, the medical community is not a homogeneous whole. Rather, hospitals and other medical facilities comprise separate departments having diverse purchasing requirements. As noted in *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc., 718 F.2d 1201, 220 USPQ 786, 791 (1st Cir. 1983)*, these departments constitute different markets for the parties' respective products.

We find that this case does not reflect any meaningful overlap in the channels of trade. The Examining Attorney's conclusions seem at odds with the real-world purchasing decisions as outlined by applicant. We conclude that the parties' respective products are different, with distinct channels of trade.

Unlike registrant's **[*8]** products, applicant's products are "fitted" by a specialized surgeon in hospital operating rooms or other in-patient critical care settings. Registrant's goods are functionally quite different. They would almost always be fitted in an outpatient setting. They are used primarily in the field of occupational medicine, by medical doctors specializing in rehabilitation medicine and by other clinicians in related fields.

The Board is convinced that orthopedic hip implantation is a highly specialized medical area. The applicant and the Trademark Examining Attorney agree that the purchaser [4] for the purposes of trademark analysis comprises a most sophisticated market.

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[4] The ultimate "consumer" of applicant's device is hoping to get a working hip -- she/he is not buying a medical apparatus. *Cf. Continental Plastic Containers Inc. v. Owens-Brockway Plastic Products Inc., 141 F.3d 1073, 46 USPQ2d 1277 (Fed. Cir. 1998)*. The hip implant patient is technically the end-user of these sophisticated medical devices and related healthcare services. In most cases, the patient will have chosen a medical facility or surgeon based upon the reputation of the unit, or even the renown of a particular orthopedic surgeon. It would stretch

There may be nuances of difference in their conclusions as to which professional on the hospital team chooses among competing vendors of this type of medical apparatus. In any event, a small and select group of medical professionals -- the orthopedic surgeon, operating room nurse supervisors and hospital administrators or purchasing agents or committees -- decides which firm or firms will be supplying the implants. As applicant has pointed out, ultimately the critical recommendation, if not the final decision, is made **[*9]** by the surgeon.

[Illegible Page 9]

earlier, registrant has quite a different market, we conclude that the parties have disparate channels of trade.

The realities of the relevant marketplace make confusion of the marks for these dissimilar goods decidedly unlikely. The potential number of customers who would be dealing with both companies in two separate, specialized medical areas is minuscule or **[*10]** even non-existent. We find that any overlap in customers is too small to be significant. Inasmuch as this small population consists entirely of highly educated, sophisticated, health-care professionals any potential overlap is not dispositive in this case.

This brings us to consideration of the parties' marks. The applicant and the Trademark Examining Attorney also disagree over just how significant are the similarities or differences in the two marks.

Registrant's mark is "X-TEND." Arguably, registrant's mark would be pronounced the same as if it comprised the word "extend." Applicant has adopted the mark "EXTEND," an ordinary word in the English language, used here in a somewhat suggestive manner for hip implants. Considering the marks in their entireties, applicant's mark and registrant's mark are identical phonetically but different in appearance. As noted above, even if there should be a remote chance of some overlapping of ordering personnel in the hospital setting, these are not items where the purchasing transactions would be completed orally.

The target audience for applicant's medical appliances comprises sophisticated medical professionals. Hence, the fact that the **[*11]** marks "EXTEND" and "X-TEND" differ in appearance mitigates against a finding of likelihood of confusion. The sophisticated buyers -- physicians and/or hospital purchasing agents -- would readily recognize the difference in the appearance of the marks if she or he is acquainted with one mark and subsequently sees the other.

A decade ago, the Board had occasion to decide another case where the first syllable of the two-syllable marks differed visually in a remarkably similar way to these two marks. In *Information Resources Inc. v. X* Press Information Services, 6 USPQ2d 1034 (TTAB 1988)*, the Board held that the simultaneous use of the mark "EXPRESS" on information software and the mark "X*PRESS" for service comprising the transmittal of information to computers -- expensive items purchased with care and thought -- is not likely to result in confusion, since *inter alia*, the marks *differ significantly in appearance*, (emphasis supplied). More recently, the Board found that two marks of quite similar appearances -- "DIGIRAD" and "DIGIRAY" -- would not result in a likelihood of confusion although both were being used on medical equipment sharing many of the **[*12]** same characteristics. [6] In the intervening decade, our principal reviewing court reached a consistent result in an *inter partes* contest, also in the medical field (E.D.S. v. EDS). [7]

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credulity to believe that patients fitting the general profile of candidates for hip replacement surgery are involved in comparison shopping among manufacturers of such specialized medical apparatus.

[6] The Board found no likelihood of confusion between applicant's DIGIRAD mark intended to be used on nuclear imaging equipment, and registrant's DIGIRAY and design mark, used on x-ray imaging equipment. These goods were found not to be closely related given the differences in relevant purchasers of these goods, the sophistication of those purchasers, the care with which such products are purchased, and the relative expense of both products. The Board reached this conclusion even though both x-ray imaging and nuclear imaging are medical diagnostic technologies, both technologies involve use of a form of radiation, and both types of imaging may be performed on patients during diagnosis and/or treatment of an illness or injury. *In re Digirad Corp ., 45 USPQ2d 1841 (TTAB 1998)*.

[7] The Court found no likelihood of confusion between "E.D.S.," for battery chargers and power supplies incorporated into medical instruments, and "EDS," for computer services sold to customers, *inter alia*, in the medical field, noting that the purchasers are substantially different and are usually sophisticated. *Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 21 USPQ2d 1388 (Fed. Cir. 1992)*.

[*13]

Given the differences in the nature of the respective goods; the differing marketing and trade channels involved; the sophistication of the medical professionals -- especially physicians; the narrow scope of applicant's goods; and the *de minimus* chance of any potential overlap in the respective customers, we find that the respective marks are not so similar that confusion as to the origin or affiliation of applicant's and registrant's medical equipment would be likely to occur.

Accordingly, we find no likelihood of confusion between applicant's mark "EXTEND," for orthopedic hip implants and registrant's mark "X-TEND" for carpal tunnel supports, thumb/wrist supports, and back braces for medical and therapeutical use.

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Exhibit B

2000 TTAB LEXIS 626

Trademark Trial and Appeal Board

September 18, 2000, Decided

Opposition No. 105,024,925 to application Serial No. 75/024,925 filed on November 28, 1995

Reporter
2000 TTAB LEXIS 626 *

SmithKline Beecham Pharmaceuticals Company v. L. Molteni & C. dei F.lli Alitti S.p.A.

Disposition: [*1]

Decision: The opposition is dismissed.

Core Terms

diabetes, pharmaceutical, diuretic, marks, antihypertensive, patients, suffix, preparations, prefix, prescription, products, registrations, pharmacists, prescribed, hypertension, third-party, medications, notice, advertising, appearing, active ingredient, articles, pharmaceutical company, prescription drug, sales, top, hydrochlorothiazide, pharmacies, generic, famous

Counsel

Roberta Jacobs-Meadway, Karol A. Kepchar and Scott W. Goode of Panitch Schwarze Jacobs & Nadel, P.C. for SmithKline Beecham Pharmaceuticals Company.

Lawrence E. Abelman and Julie Seyler of Abelman, Frayne & Schwab for L. Molteni & C. dei F.lli Alitti S.p.A.

Panel: Before Hanak, Hohein and Hairston, Administrative Trademark Judges.

Opinion By:

Hohein, G. Douglas

Opinion

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Opinion by Hohein, Administrative Trademark Judge:

L. Molteni & C. dei F.lli Alitti S.p.A. has filed an application to register the mark "DIABREZIDE" for "pharmaceutical preparations for diabetes." [1]

SmithKline Beecham Pharmaceuticals Company has opposed registration on the ground that applicant's mark, when applied to applicant's goods, so resembles the mark "DYAZIDE," which opposer has previously used in connection with "diuretics and antihypertensive pharmaceuticals" and has registered for a "diuretic," [2] as to be likely to cause confusion, mistake or deception.

[*2]

Applicant, in its answer, has denied the salient allegations of the notice of opposition. [3]

The record includes the pleadings; the file of the involved application; and, as part of opposer's case-in-chief, the testimony, with exhibits, of Meg Begley, its "DYAZIDE" product manager. As the rest of its case-in-chief, opposer has submitted notices of reliance upon (i) a certified copy of its pleaded registration showing that the registration is subsisting and owned by opposer; (ii) applicant's answers to certain of opposer's interrogatories; and (iii) copies of various articles from printed publications of general circulation. Applicant, as its case-in-chief, has furnished the testimony, with exhibits, of Giuseppi Seghi Recli, its managing director, and has filed notices of reliance on (i) opposer's answers to certain of applicant's interrogatories; (ii) copies of a number of third-party registrations; (iii) copies **[*3]** of excerpts from several medical reference works, including medical dictionaries; and (iv) copies of selected articles from printed publications of general circulation. The record contains no rebuttal evidence. Briefs have been filed, but an oral hearing was not requested.

Priority is not in issue inasmuch as the certified copy of opposer's pleaded registration shows that such registration, as noted above, is subsisting and owned by opposer. See *King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)*. In any event, the record also sufficiently establishes, as discussed below, that opposer is the prior user of its pleaded "DYAZIDE" mark in the United States. The only real issue to be determined, therefore, is whether applicant's "DIABREZIDE" mark, when used in connection with pharmaceutical preparations for diabetes, so resembles opposer's registered and/or previously used "DYAZIDE" mark for, respectively, diuretics and antihypertensives as to be likely to cause confusion as to the source or sponsorship of the parties' goods.

According to the record, opposer is one of the top ten pharmaceutical companies and is very well known **[*4]** in the pharmaceutical field. Opposer sells a variety of prescription drugs, including central nervous system products, antiarthritics, antiinfectives, antivirals, oncology products, cardiovascular products and endocrinology products. Opposer also sells over-the-counter drugs through its consumer health care subsidiary. One of its top three pharmaceuticals is a diuretic which, since the introduction thereof in the early 1960s, has continuously been sold by opposer under the mark "DYAZIDE" for use chiefly as an antihypertensive. Opposer's "DYAZIDE" product lowers blood pressure in patients through diuresis; that is, it removes water from the body but is potassium sparing. The "DYAZIDE" product, however, is a prescription rather than an over-the-counter drug and has always been such.

Opposer sells its "DYAZIDE" product only to wholesalers, who in turn distribute it to hospitals, pharmacies, managed care facilities and nursing homes for use by patients for control principally of hypertension (high blood pressure). While opposer's witness testified that the "DYAZIDE" mark was coined by opposer, it is clear from the record that the suffix "-ZIDE" is derived

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[1] Ser. No. 75/024,925, filed on November 28, 1995, based upon an allegation of a bona fide intention to use such mark in commerce.

[2] Reg. No. 755, 837, issued September 3, 1963, which sets forth dates of first use of January 7, 1963; first renewal.

[3] While the answer also sets forth various allegations as "AFFIRMATIVE DEFENSES," the allegations are merely amplifications of applicant's denials of the salient allegations of the notice of opposition and therefore are not, properly speaking, affirmative defenses.

from, and hence is suggestive **[*5]** of, hydrochlorothiazide, which is one of the active ingredients in opposer's diuretic as well as a number of other antihypertensives, and that the prefix "DY-," which is the phonetic equivalent of the prefix "DI-," is derived from, and thus is suggestive of, a diuretic. For many years, "DYAZIDE" has been "a considerable product" for opposer and, in 1994, opposer reformulated such product so as to make it available in a new strength. (Begley dep. at 12.) However, according to Ms. Begley, who from 1991 to 1995 was a sales representative for opposer before becoming "DYAZIDE" product manager in August of 1995, such product "was so well known [among doctors that] there was not a lot of educational effort involved" insofar as making physicians aware of the drug's benefits for patients with hypertension. (Id. at 14.) Moreover, despite the expiration of patent protection for opposer's "DYAZIDE" product and the increasing availability of generic substitutes since 1997, such product has remained the standard for antihypertensive diuretics of its kind.

Ms. Begley affirmed that hypertension is a condition which can occur in persons with diabetes. While, as a graduate of Rosemont College **[*6]** with a Bachelor's degree in French, she conceded that she is "not a diabetics expert," she indicated that "because of what's going on endocrinologically they . . . have more problems cardiovascularly than others, and hypertension is one of the ways that that manifests itself." (Id. at 20-21.) In particular, she testified that:

> Q. Do you have any idea what percentage of diabetic patients may suffer from hypertension?
>
> A. I would say it's more than half, maybe 60%.

(Id. at 21.) She additionally pointed out that opposer's "DYAZIDE" product would be prescribed by a wide variety of doctors and specialists, including endocrinologists and "anyone who's treating a patient who would likely have high blood pressure." (Id. at 17.)

Opposer advertises and otherwise promotes its "DYAZIDE" product to doctors by detailing it in consultations conducted by sales representatives, [4] staffing booths at medical conventions, running advertisements in medical journals, sending direct mail flyers, providing product literature and free samples for distribution to patients, and furnishing other "give-aways," such as writing tablets, pocket lab test guides and calipers for quick reading **[*7]** of EKG charts, which bear the mark. While ads appearing in certain journals target the "DYAZIDE" product to, for example, primary care physicians, family practitioners, general practitioners and cardiologists, the product is also advertised in publications "that every doctor reads regardless of their specialty," such as the Journal of the American Medical Association and the New England Journal of Medicine. (Id. at 38.) Opposer also runs ads for its "DYAZIDE" product which are directed to pharmacists in such journals as Drug Topics, Pharmacy Times, U.S. Pharmacist, Triple I Prescribing Guide and Monthly Prescribing Reference. The "DYAZIDE" product, furthermore, is listed, as is the case with other medications in actual use, in the Physicians' Desk Reference, an annual compilation which sets forth indications [5] for pharmaceuticals and their prescribing information. [6]

[*8]

The "DYAZIDE" mark is used on packaging, product literature and prescribing information. The product itself is available in single unit packages of 100 capsules, patient starter packages of four capsules, and bottles of 100 and 1,000 capsules. Sales of the "DYAZIDE" product in 1997, the last year for which such figures were available (and not stated to be confidential), were in excess of $ 48.9 million. According to Ms. Begley, during the time in the 1990s in which she has been involved with the "DYAZIDE" product, sales thereof have been substantial and such drug has been an important product for opposer. [7]

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[4] The term "detailing," according to Ms. Begley, involves a process of first calling on doctors and "explaining a . . . disease state and what to look for, and then . . . explaining to them why your product works in this disease state. And then you may explain to them why your product should be the one chosen or used over a competitor." (Begley dep. at 14.) While a detailing session can last a couple of minutes to a half an hour, on average the duration is "eight to ten minutes." (Id. at 37.)

[5] According to Ms. Begley, an "indication" is "clearance that the FDA has given for a particular product to be sold for a particular disease state." (Id. at 19.)

[6] Ms. Begley noted in her testimony that, in addition to physicians, nurses and pharmacists, she "know[s] a lot of lay people who read" such publication. (Id. at 46.)

[7] Although opposer's witness did not testify as to any specific sales figures other than those for 1997, she did identify opposer's Exhibit 17 as a listing of sales and advertising amounts for the years 1964 through 1996. Furthermore, even though marked "CONFIDENIAL

Moreover, while it appears that annual sales of the "DYAZIDE" product peaked around 1986 and have steadily declined since then, annual sales have remained "considerable," with several million prescriptions for the product having been written in 1997 and another couple of hundred thousands therefor having been written in January 1998 alone. (Id. at 59.) In the case of advertising and promotional expenditures, Ms. Begley conceded that, with the coming of generic substitutes in 1997, opposer has backed off its spending thereon, but it is still the case that it has expended **[*9]** appreciable sums, totaling in the neighborhood of a couple hundred million dollars, to advertise and promote its "DYAZIDE" product since the introduction thereof around 1963. [8] However, at present the product is not actively promoted.

In addition, as to the commercial **[*10]** success of opposer's "DYAZIDE" product and the asserted fame of such mark, Ms. Begley testified as follows:

> Q. Do you believe that the Dyazide product is well known among patients who have hypertension?
>
> . . . .
>
> A. I believe it, yes.
>
> Q. Based on what?
>
> A. Based on the fact that so many people are still using Dyazide.

(Id. at 69.) Furthermore, opposer also offered, by means of a notice of reliance, a number of unsolicited articles appearing in the popular press which happen to mention its "DYAZIDE" product.

As of the March 19, 1998 date of her testimony, Ms. Begley noted that opposer does not sell a drug for the treatment of diabetes. She added, however, that opposer does have plans for a diabetes drug, but conceded that she does not have any involvement therewith and did not provide any specifics as to such plans. Finally, with respect to any third-party marks which are similar to opposer's mark, she testified as follows:

> Q. Are you aware of any trademarks other than "Dyazide" that start with a D-Y-A and end in Z-I-D-E?
>
> A. No.
>
> Q. Are you aware of any trademarks that start with D-I-A and end in Z-I-D-E?
>
> A. No.

(Id. at 73-74.) Ms. Begley admitted **[*11]** on cross-examination, however, that she was familiar with competitors of opposer using marks, such as "MAXZIDE," which utilize as a portion thereof the suffix "-ZIDE" in connection with diuretics/antihypertensives in which a major ingredient, like opposer's "DYAZIDE" product, is hydrochlorothiazide.

Applicant is an Italian pharmaceutical company located in Florence, Italy. Its "DIABREZIDE" product, of which the active ingredient is gliclazide, is "for the treatment of non-insulin dependent diabetes mellitus." (Rechi dep. at 2.) Although applicant's managing director has no direct knowledge of the derivation of such mark since applicant bought the mark and its associated product from another Italian pharmaceutical company in 1991, Mr. Rechi testified that he suspected that the "-ZIDE" suffix is reflective of the suffix portion of the name of the active ingredient in the "DIABREZIDE" product while the prefix "DIAB-" is obviously suggestive of a diabetes treatment.

Although applicant is currently using its "DIABREZIDE" mark in Italy on product packaging for its prescription pharmaceutical preparation for diabetes, such mark is not in use in the United States for any goods nor is the **[*12]** associated product sold in the United States. Likewise, applicant has not advertised or otherwise promoted its "DIABREZIDE" product in the United States; such product has not been discussed at any conferences or professional meetings here; and it has not been the subject of any clinical trials conducted here or of any other studies that have been reviewed or presented here. In short, while

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ATTORNEY'S EYES ONLY," opposer's main brief nevertheless sets forth specific sales and advertising totals for such period as well as for the late 1980s. While we will not state those figures in this opinion since they were offered as confidential business information, suffice it to say that sales of opposer's "DYAZIDE" product during the 33-year period covered by Exhibit 17 exceed several billion dollars and totaled a few hundred million dollars in the late 1980s.

[8] Again, while opposer's main brief lists a specific total amount, such amount is not set forth in this opinion since it was indicated at trial to be confidential business information.

the "DIABREZIDE" product is not sold or marketed in the United States, applicant insists that it intends to use such mark in the United States, but only in connection with a prescription product for treatment of non-insulin dependent diabetes millitus.

Applicant, moreover, does not manufacture or sell a prescription or non-prescription diuretic/antihypertensive drug and it is not in applicant's "actual foreseeable plans" to do so. (Id. at 18.) Mr. Rechi admitted, however, that patients with diabetes may suffer from hypertension, but he claimed to lack the medical background necessary to know whether such conditions occur often in the same patient as claimed by Ms. Begley.

In addition, Mr. Rechi conceded on cross-examination that he is not aware of any pharmaceutical mark other than "DIABREZIDE" **[*13]** which combines both a "DIA-" prefix and a "-ZIDE" suffix. Similarly, he stated that he knows of no pharmaceutical mark other than "DYAZIDE" which combines both a "DYA-" prefix and a "-ZIDE" suffix. He further testified, however, that based upon consultation of the 1998 edition of Physicians' Desk Reference, he has personal knowledge that the following marks are in use in the United States for diuretics and/or antihypertensives which have hydrochlorothiazide as an active ingredient: "PRINZIDE," "CAPOZIDE" and "ALDACTAZIDE". Nevertheless, Mr. Rechi also testified that he had never seen any packaging for such products nor did he have any knowledge as to how long the products have been sold in the United States.

Like opposer, applicant promotes its "DIABREZIDE" product by having sales representatives detail the goods to physicians and intends to detail such product to doctors in the United States. [9] However, unlike the "DYAZIDE" antihypertensive sold by opposer, applicant obviously has no need to detail its "DIABREZIDE" diabetes drug to cardiologists. While applicant, like opposer, has distributed samples of its product to doctors, Mr. Rechi claims that whether applicant intends **[*14]** to do such in the United States "will depend on the marketing strategy adopted." (Id. at 41.) Applicant, in addition, details its "DIABREZIDE" product directly to hospitals, but whether it intends to do so as to hospitals in the United States likewise "will depend on the marketing strategy adopted." (Id.)

Applicant's "DIABREZIDE" product, unlike opposer's "DYAZIDE" product, has not received any coverage in the media. The former also has not been submitted to the U.S. Food and Drug Administration or any other U.S. regulatory agency for approval. According to Mr. Rechi, he first became aware of applicant's "DYAZIDE" product on receiving the notice of opposition which commenced this proceeding. He also testified that he is unaware of any occasion in which there was confusion between the respective marks, noting **[*15]** that no one has ever expressed a concern or otherwise mentioned to him that the marks "DIABREZIDE" and "DYAZIDE" are similar.

Finally, by notice of reliance applicant has shown that a number of articles appearing in printed publications of general circulation make mention of third-party marks featuring the suffix "-ZIDE" for various medications, including preparations for treatment of hypertension such as "OPTIZIDE," "MICROZIDE," "RAUZIDE," "MINIZIDE," "PRINZIDE," "MAXZIDE," "APRESAZIDE," "HYDRA-ZIDE" and "ALDACTAZIDE," while two other articles refer to the third-party mark "DIABEX," which utilizes the prefix "DIA-" in connection with a product which is an oral antidiabetic drug. Another notice of reliance by applicant reveals that primary or active ingredients listed for various brands of antihypertensives are polythiazide in the case of the "MINIZIDE" product and hydrochlorothiazide in instances of the "PRINZIDE," "CAPOZIDE" and "ALDACTAZIDE" products. Additionally, a notice of reliance by applicant is accompanied by copies of numerous third-party registrations for marks with the suffix "-ZIDE," including those for diuretics and/or antihypertensives such as "LOZIDE," "MICROZIDE, **[*16]** " "RAUZIDE," "MINIZIDE," "PRINZIDE," "MAXZIDE," "APRESAZIDE," "ALDACTAZIDE," "HYDROZIDE" and "VISKAZIDE," along with several other third-party registrations for marks with the prefix "DIA-," including those for pharmaceutical preparations for treating diabetes such as "DIAMICRON" and "DIABEX."

Turning to the issue of likelihood of confusion, we find upon consideration of the pertinent factors set forth in *In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973)*, that on this record confusion as to source or affiliation is not likely to occur. As a starting point, it is plain that while the respective goods are prescription pharmaceutical preparations which would be sold through the same channels of trade, such as wholesale, retail and hospital pharmacies, managed care facilities and nursing homes, and would be prescribed by physicians for purchase and use, ultimately, by patients

[9] Mr. Rechi testified that, in the context of promoting pharmaceutical products, he understood the term "detailing" to mean "bringing to the physician's attention the product's properties." (Rechi dep. at 37.) He further noted, however, that applicant is not certain whether it will detail pharmacists in the United States with respect to its "DIABREZIDE" product.

from the general public, the goods are nevertheless specifically directed to different indications. Opposer's diuretic is principally utilized as an antihypertensive while applicant's product is for the treatment of diabetes. Although the record indicates that hypertension **[*17]** and diabetes can coincide in the same patients and that, in particular, hypertension can occur in up to 60 percent of persons with diabetes, the fact remains that such medical conditions are not the same illness. Hence, the drug treatments therefor, even though they may be prescribed in many instances by the same doctor, are not identical.

Moreover, on this record, there is nothing which shows that the same pharmaceutical companies market both diuretics and/or antihypertensives, on the one hand, and preparations for the treatment of diabetes, on the other, much less that such is done under the same or similar marks. Here, not only does applicant not market an antihypertensive and has no plans to do so in the foreseeable future, but it is particularly telling that opposer, which is a top ten pharmaceutical company and is very well known in such field, does not sell a drug for the treatment of diabetes. Although opposer's witness testified to a generalized intent on the part of opposer as to plans for a diabetes drug, she provided nothing specific. Physicians, pharmacists, nurses and others in the pharmaceutical field would thus not be conditioned to expect that the same drug company **[*18]** typically makes and/or sells any and all kinds of pharmaceutical preparations.

The conditions of sale surrounding prescription pharmaceuticals also lessen the prospects for any likelihood of confusion as to product origin or affiliation. Specifically, the industry standard practice of company sales representatives calling upon doctors and pharmacists to educate and advise them with respect to the company's prescription drugs and their indications necessarily means that such customers would typically know the source of the pharmaceutical preparations they prescribe and/or buy. Notwithstanding that such detailing sessions on average last only eight to ten minutes, physicians, pharmacists and nurses are, by the very nature of their professions, highly knowledgeable and sophisticated customers when it comes to medications, given their training in pharmacology and the care, due to the recognized potential for harmful drug interactions, they must exercise in prescribing medications for particular indications. See, e.g., *Warner-Hudnut, Inc. v. Wander Co., 280 F.2d 435, 126 USPQ 411, 412 (CCPA 1960)* [physicians and pharmacists constitute "a highly intelligent and discriminating **[*19]** public"]. While patients, as the ultimate consumers, would admittedly lack such specialized knowledge, it must be remembered that unlike the case with over-the-counter medications, it is the patient's doctor or pharmacist which, in the case of prescription drugs, selects the medication and the patient, relying upon the expertise of the medical practitioner, simply has his or her prescription filled without the need for any deliberation.

Furthermore, while the record contains testimony that it is becoming an increasingly common practice in the industry, due to a generalized shortage of and the expenses associated with sales representatives, for pharmaceutical companies to detail the prescription drugs of other such companies as well as those of their own, this development does not increase the prospects for confusion as to origin or affiliation to occur. In particular, it is highly unlikely that if, as contended by opposer, confusion as to source or sponsorship is likely from the contemporaneous sale and marketing of its "DYAZIDE" diuretic/antihypertensive and applicant's "DIABREZIDE" diabetes treatment, opposer would detail applicant's product in conjunction with its own or authorize **[*20]** applicant to detail opposer's product along with applicant's pharmaceutical preparation. Contrary to opposer's contentions, circumstances simply do not exist which, as a practical matter, would foster a likelihood of confusion among the parties' prescription drug products. [10] The conditions of sale, instead, are such that the respective goods would be marketed primarily to careful and sophisticated medical professionals who plainly would not impulsively select and prescribe the products for their patients.

[*21]

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[10] While it is possible that another pharmaceutical company might detail both opposer's products as well as those of applicant, it seems unlikely that opposer would knowingly allow such a situation to occur. Moreover, as our principal reviewing court has cautioned in this regard:

> We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.

Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), quoting from *Witco Chemical Co. v. Whitfield Chemical Co., 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969)*, *aff'g*, *153 USPQ 412 (TTAB 1967)*.

As to the respective marks, we agree with applicant that they are distinguishable, both by those in the medical and pharmacy fields as well as by patients, with respect to sight, sound, connotation and commercial impression. Admittedly, there are similarities between the marks "DYAZIDE" and "DIABREZIDE" in that both begin, respectively, with the same sounding prefixes, "DYA-" and "DIA-," and both end with the identically appearing and pronounced suffix, "-ZIDE." However, when considered in their entireties, not only is the letter "Y" in the first syllable of opposer's three-syllable mark visually distinct, but significantly, the additional syllable "BRE" in applicant's four-syllable mark is totally dissimilar in sight and sound from opposer's mark. While there is no correct pronunciation of a mark, we essentially concur with applicant that, overall, even allowing for "[t]he fact that the letter 'y' will be pronounced as in 'why', DYAZIDE or DIE-A-ZIDE sounds not at all like DI-A-BRE-ZIDE" and that, furthermore (**emphasis by applicant**):

> Given the presence of the BRE-syllable, it would be highly unlikely for a purchaser to fail to pronounce Applicant's mark as DI[-]A- **[*22]** **BRE**-ZIDE. Similarly, a purchaser would only pronounce DYAZIDE as DY[-]A[-]ZIDE . . . [and] would not insert an extra middle syllable. Thus, taking into account the fundamental principle of law that any inquiry as to whether the marks "sound alike" must focus on the "usual pronunciation by the ordinary consumer," *Smithkline Beckman, Corp. v. Proctor & Gamble Co., 223 U.S.P.Q. 1230, 1237 (N.D.N.Y 1984)*, it becomes apparent that the marks bear no [significant] verbal similarity.

Additionally, we concur with applicant that the marks at issue are connotatively distinguishable. Opposer's "DYAZIDE" mark is registered for a diuretic used as an antihypertensive. The compound hydrochlorothiazide is one of the active ingredients in opposer's "DYAZIDE" product and is also an active component of several third-party diuretics/antihypertensives available in the United States under such registered marks as "ALDACTAZIDE," "PRINZIDE" and "MAXZIDE" and the mark "CAPOZIDE". All of such marks feature the suffix "-ZIDE," which is also a formative in several other marks which are the subjects of third-party registrations for diuretics and/or antihypertensives, such as **[*23]** "LOZIDE," "MICROZIDE," "RAUZIDE," "MINIZIDE," "APRESAZIDE," "HYDROZIDE" and "VISKAZIDE." Although third-party registrations do not establish that the marks which are the subjects thereof are in use and that the purchasing public is familiar therewith, such registrations may be given some weight to show the meaning of a mark in the same way that dictionaries are used. See, e.g., *Tektronix, Inc. v. Daktronics, Inc., 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976)*.

Here, it is apparent that, rather than being arbitrary, the suffix "-ZIDE" is highly suggestive of an active ingredient of diuretic/antihypertensive pharmaceutical products and it is plain, in light of the several third-party marks acknowledged to be in actual use, that physicians, pharmacists, nurses and others in the medical field are accustomed to distinguishing among marks containing the suffix "-ZIDE." Moreover, irrespective of the presence of a "Y" instead of an "I" in the first syllable of opposer's mark, it is clear that that the prefix "DY-" is the phonetic equivalent of the prefix "DI-" and is thus suggestive of a diuretic.

Consequently, to those with training in medicine, pharmacology or nursing, **[*24]** opposer's "DYAZIDE" mark is suggestive of a diuretic which contains hydrochlorothiazide as a major ingredient. Applicant's "DIABREZIDE" mark, by contrast, is connotatively different in that the "-ZIDE" suffix thereof is suggestive of a different active ingredient, namely, gliclazide, and the prefix "DIA-," as confirmed by the third-party registrations for such marks as "DIAMICRON" and "DIABEX" for pharmaceutical preparations for treating diabetes, is suggestive of a diabetes treatment. Applicant's mark, therefore, intimates to doctors, nurses and pharmacists that it is a gliclazide-based preparation for use against diabetes.

Overall, given the above-noted differences in sound, appearance and connotation, we find that applicant's "DIABREZIDE" mark for its pharmaceutical preparations for diabetes so differs in commercial impression from opposer's "DYAZIDE" mark for its diuretic for antihypertensive use that confusion as to the source or sponsorship of the parties' prescription drug products would not be likely to occur. The differences in suggestiveness of the first and last syllables of each mark, as well as the differences in sound and appearance due to the presence of the additional **[*25]** syllable "BRE" in applicant's mark, sufficiently distinguish the marks at issue, notwithstanding that such marks, as argued by opposer, "incorporate both a 'DYA/DIA' prefix and a '-ZIDE' suffix . . . ." See, e.g., *Tektronix, Inc. v. Daktronics, Inc., supra at 694* ["[b]ecause marks, including any suggestive portions thereof, must be considered in their entireties, the mere presence of . . . common, highly suggestive portion[s] is usually insufficient to support a finding of likelihood of confusion"].

Furthermore, as to the patients for whom the parties' medications have been prescribed, including those who are under treatment for both diabetes and hypertension, it is conceded that while the differences in suggestiveness of the "-ZIDE" suffix

would not be apparent, it is still the case that the marks are sufficiently distinguishable. Plainly, even if patients are unaware of its meaning, the "-ZIDE" suffix is a commonly adopted formative for pharmaceutical preparations and the suggestiveness of the prefix "DY-" as used in connection with a diuretic and the prefix "DIA-" for a diabetes medication would still be readily apparent, even to persons lacking in medical, pharmacological **[*26]** or nursing backgrounds. Thus, even among the ultimate consumers of the parties' prescription pharmaceutical products, the marks "DYAZIDE" and "DIABREZIDE" are distinguishable and confusion, including the risk of harm from mistaking one brand of medication for another, is not likely. [11]

[*27]

Opposer, however, claims in the recitation of facts in its initial brief that its "DYAZIDE" mark is famous and, hence, is entitled to a broad scope of protection. As indicated by our principal reviewing court in *Kenner Parker Toys Inc. v. Rose Art Industries Inc., 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992)*, *cert. denied*, *506 U.S. 862, 113 S.Ct. 181 (1992)*, "the fifth *duPont* factor, fame of the prior mark, plays a dominant role in cases featuring a famous or strong mark. Famous or strong marks enjoy a wide latitude of legal protection." We find, however, that on this record opposer simply has not proven its assertion of fame for its "DYAZIDE" mark.

In particular, while Ms. Begley testified, as noted earlier, that "DYAZIDE" has been "a considerable product" for opposer for many years, that it has remained the standard for pharmaceuticals of its kind and that she believes that such product "was so well known [among doctors that] there was not a lot of educational effort involved" insofar as detailing the drug's benefits, such opinions do not mean that opposer's "DYAZIDE" product had in fact become famous and/or that it still is. Although **[*28]** the record also establishes, in particular, that opposer has enjoyed substantial sales of its "DYAZIDE" product, amounting to nearly $ 49 million in 1997 alone, and since the early 1960s has had significant and continuing commercial success with such product, despite recently declining sales due in part to the introduction in 1997 of generic substitutes, the record gives no indication as to the overall size of the market for diuretics/antihypertensives and, thus, what percentage share thereof the "DYAZIDE" product constitutes for opposer. Therefore, while we again note that opposer is presently one of the top ten pharmaceutical companies and its "DYAZIDE" product is one of its top three products, we cannot conclude therefrom that the "DYAZIDE" mark is necessarily famous.

Moreover, opposer has submitted only a few examples of its advertising and promotional efforts over the years for its "DYAZIDE" product, such as a direct mail flyer distributed to physicians and pharmacists over five years ago to announce the reformulation of the "DYAZIDE" product in 1994. Of the other examples of its advertising and promotional materials in the record, including photographs of convention exhibit **[*29]** booths, sample give-a-ways, a couple of trade journal ads and a piece of educational patient literature, only the latter has additionally been directed to members of the general public rather than solely to pharmacists and those in various medical professions.

Opposer appears, from its notice of reliance on excerpts from publications of general circulation, to base its claim of fame for its "DYAZIDE" mark in large measure on articles mentioning such mark principally in medical and pharmaceutical journals and occasionally in general interest newspapers and magazines. In particular, opposer points to an article from the July 1991 issue of FDA Consumer in which "DYAZIDE" is ranked sixth on a list of ten prescription drugs most often dispensed in U.S. pharmacies in 1990. In addition, it has not escaped our notice that a survey reported in the April 1994 edition of American Druggist listed "DYAZIDE" as thirtieth among the top 200 most prescribed drugs during 1993, down from its ranking as

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[11] It would appear to be speculative at best as to whether applicant's "DIABREZIDE" product for treatment of diabetes, if it is cleared for sale in the United States, and opposer's "DYAZIDE" product for control of hypertension would both be routinely prescribed for diabetes patients with hypertension. As stated in the excerpt about "DYAZIDE" made of record by opposer from The Pill Book (7th ed.), consumers are cautioned under the heading of "Drug Interactions" that "[i]f you begin taking Insulin or an oral antidiabetic drug and begin taking Dyazide, the Insulin or antidiabetic dose may have to be modified." Further, under the heading of "Special Information," such publication warns that "[d]iabetic patients may experience an increased blood-sugar level and a need for dosage adjustments of their antidiabetic medicines." If true, it would thus seem questionable as to whether applicant's and opposer's products would be the prescription drugs of choice for treatment of diabetic patients who develop or have hypertension. Clearly, as pointed out in the excerpt from the Physicians' Desk Reference (52d ed. 1998), made of record by opposer as Exhibit 10 to Ms. Begley's deposition, "DYAZIDE" is contraindicated for use in diabetic patients with hyperkalemia (preexisting elevated serum potassium) in that: "Hyperkalemia has been reported in diabetic patients with the use of potassium-sparing agents even in the absence of apparent renal impairment. Accordingly, serum electrolytes must be frequently monitored if *Dyazide* is used in diabetic patients."

twenty-fourth in 1992. A similar survey appearing in the February 1997 issue of the same publication reveals, however, that among the top 200 most frequently dispensed drugs by community pharmacies, **[*30]** "DYAZIDE" had dropped to number 116 by 1996, with roughly 3,857,000 prescriptions, falling from number 76 in 1995. Nevertheless, opposer concludes from such evidence and passing mentions of "DYAZIDE" in the popular press as the brand name of a diuretic that: "As a result of Opposer's efforts and expenditures, 'DYAZIDE' product has received substantial unsolicited press coverage as being among the leading pharmaceuticals for the treatment of hypertension . . . ."

There are several reasons why we cannot agree with opposer's conclusion. First, to the extent that opposer is relying upon the articles excerpted from publications in general circulation for the truth of the statements therein (e.g., the ranking in prescription popularity of its "DYAZIDE" product for certain years), as opposed to what they show on their face (e.g., the mentioning of the mark "DYAZIDE"), such evidence constitutes inadmissible hearsay which has not been shown to be within any exception thereto. *Fed. R. Evid. 801*, *802* and *803*; and TBMP Section 708. Second, the exceedingly small number of excerpts furnished **[*31]** by opposer scarcely amounts to a demonstration of "substantial unsolicited press coverage," especially when consideration is given to the fact that its "DYAZIDE" product has been on the market since the early 1960s. Finally, even if the articles were to be accepted, in light of the lack of any objection from applicant in its brief, for the truth of the statements contained therein, it is apparent that any possible renown which opposer's "DYAZIDE" product may have at one time otherwise enjoyed has eroded appreciably, given the plunge in prescriptions for such medication during the 1990s.

In view thereof, and inasmuch as opposer, after the introduction of competition from generic substitutes in 1997, in any event no longer actively promotes its "DYAZIDE" product, we cannot concur with the assertion in opposer's initial brief that its "'DYAZIDE' product is . . . extremely well known among the physicians who write the prescriptions and the pharmacists that fill them, as well as among patients who receive treatment for hypertension, including diabetics . . . ." That is, notwithstanding that opposer, since about 1963, has expended appreciable sums, totaling in the neighborhood of a couple **[*32]** hundred million dollars, to advertise and promote its "DYAZIDE" product and has had and continues to have considerable (although declining) sales thereof, it simply cannot be said, in the notable absence of any indication as to market share, that as of the close of the trial herein opposer has proven that its "DYAZIDE" mark is famous for a diuretic/antihypertensive and that such mark is entitled to a correspondingly broad scope of protection.

E. W. Hanak

G. D. Hohein

P. T. Hairston

Administrative Trademark Judges, Trademark Trial and Appeal Board

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